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OFFICE OF PETITIONS

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In re Patent No. 6,603,052 :
Issue Date: August 5, 2003 :
Application No. 09/865,822 : DECISION ON PETITION
Filed: May 25, 2001 : UNDER 37 CFR 1.378(b)
For: TRIL-05/119 :
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This is a decision on the petition under 37 CFR 1.378(b), filed June 29, 2010, to accept an unavoidably delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). **Any such petition for reconsideration must be accompanied by the petition fee of \$400 as set forth in 37 CFR 1.17(f).** The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

The patent issued August 5, 2003. The 3.5 year maintenance fee could have been paid from August 5, 2006, through February 5, 2007, or with a surcharge during the period from February 6, 2007 through August 5, 2007. Accordingly, the patent expired February 5, 2007, for failure to timely submit the second maintenance fee. Accordingly, the patent expired August 5, 2007 for failure to timely submit the 3.5-year maintenance fee.

A petition to accept the delayed payment of a maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate showing that the delay was unavoidable, since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1).

This petition lacks item requirement (1) set forth above.

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable". 35 U.S.C. § 41(c)(1).

The patentees of record are joint inventors John E. Davis and Timothy P. Klonne. The joint inventors were partners in TollamCo, Corp. Mr. Davis is represented by counsel of the law firm of Wood, Herron & Evans, LLP (WHE).

The petition and supporting documents assert that Mr. Davis suffered a stroke around the time that the patent issued and that Mr. Davis still suffers from the effects of the stroke, including memory issues. The petition and supporting documents assert that Mr. Davis was incapacitated from the stroke from May 7, 2003 to October 2003.

The petition and supporting documents indicate that the patent was supposed to be assigned to a corporate entity, but this never occurred.

The petition and supporting documents further assert that on May 1, 2003, TollamCo, Corp closed and that the corporation was liquidated from May, 2003 to November 2003. It was agreed that Mr. Davis would maintain the corporate record for TollamCo, Corp. The corporate records are said to have been housed by Blue Horizon, Inc., a company owned by Mr. Davis' daughter. On August 8, 2003, WHE forwarded the Letters Patent to Mr. Davis at the address of his daughter. Mr. Davis' daughter was assisting him in his recovery. The letter accompanying the Letters Patent provided information concerning future maintenance fees. Thereafter, the Letters Patent was housed in a drawer at Blue Horizon, Inc. on behalf of Mr. Davis, who was not working at that time. Mr. Davis does not recall receiving or reading the original patent. Eventually, TollamCo, Corp. files were moved from Blue Horizon, Inc. to Newport Converting, another corporation owned by Mr. Davis' daughter.

Petitioner further indicates that as TollamCo, Corp. had gone out of business, there was no docketing system in place at TollamCo, Corp. for the patent. Petitioner indicates Mr. Davis did not receive or file the patent. Petitioner asserts that due to Mr. Davis' condition, he did not note the maintenance fee due dates or docket the due dates for payment.

The petition and supporting documents further assert that Mr. Davis suffers from heart failure, having undergone heart surgery on January 7, 2007, December 7, 2007, and October 20, 2008. There are further assertions that Mr. Davis remains on heavy medications and on much a restricted physical activity level.

Reminder letters sent from WHE to Mr. Davis care of TollamCo, Corp. were received due to the closure of the corporation.

Petitioner asserts that on September 22, 2009, Mr. Davis discovered the Letters Patent while going through old files. On September 22, 2009, Mr. Davis contacted his legal counsel at WHE to seek information regarding the maintenance fee for the instant patent. Mr. Davis did not pay the maintenance fee. WHE advised Mr. Davis that the maintenance fee had not been paid and that the patent was expired for non-payment of the maintenance fee. Mr. Davis indicated he wanted to revive the patent and pay the maintenance fee due. On September 25, 2009, WHE advised Mr. Davis that he was going to have to investigate the facts regarding the owner of the Patent, the actions of the owner, and provide information surrounding the patent, the

maintenance fees, and other issues in order to determine that the delay of the payment was unavoidable.

Upon investigation, Mr. Davis was unable to locate or reach joint inventor Mr. Klonne. The petition and supporting documentation assert that Mr. Klonne "verbally assigned" the patent to Mr. Davis pursuant to a telephone call. The details of this telephone call are said to be documented in a note written by Mr. Davis and dated August 14, 2003, copy of which has been provided.

The petition and supporting documents assert that as a result of the Mr. Davis' ongoing medical problems, the investigation into the failure to pay the maintenance fee and the delay in filing the petition were arduous and drawn out, but that the investigation was completed May 6, 2010.

Petitioner seemingly attributes the failure to timely remit the 3.5 year maintenance fee to Mr. Davis' ongoing health problems related to a stroke and heart failure.

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.378(b)(3).

Acceptance of late payment of a maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 41(c)(1) uses the identical language, i.e. "unavoidable delay". Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995)(quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988)). Decisions on reviving abandoned applications have adopted the "reasonably prudent person" standard in determining if the delay in responding to an Office action was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-515 (D.C. Cir. 1912); and Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141. In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

In determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray, 55 F3d at 608-609, 34 USPQ2D at 1787. It is incumbent upon the patent owner to implement steps to schedule and pay the fee, or obligate another to do so. See California Medical Products v. Technol. Med. Prod., 921 F.Supp 1219, 1259 (D. Del. 1995). That is, 37 CFR 1.378(b)(3) requires a showing of the steps in place to pay the maintenance fee, and the record currently lacks a showing that any steps were emplaced by petitioner or anyone else. In the absence of a showing that petitioner or anyone else was engaged in tracking the maintenance fee due dates, and that party had in fact been tracking the due dates with a reliable tracking system, such as would be used by prudent and careful men in relation to their most

important business, petitioner cannot reasonably show that the delay was unavoidable delay. In re Katrapat, 6 USPQ2d 1863, 1867-1868 (Comm'r Pat. 1988); California, supra. Put otherwise, the issues of Mr. Davis' personal health are immaterial in the absence of a showing that the problems he attributes to his personal health, and not the lack of any steps in place to pay the fee, caused or contributed to the delay.

As to the physical condition described by petitioner, petitioner should note that under the circumstances of this case, he will have to provide documents from licensed health care providers, demonstrating the nature and extent of petitioner's incapacitation, in such a manner that petitioner was, from the date of expiry until the filing of the instant petition, "unavoidably" prevented from taking any earlier action with respect to this patent. Additionally, petitioner must state how he managed to conduct his daily personal and business affairs, including scheduling and settlement of short and long term debts and business obligations, bills, rent or mortgage payments, income taxes etc., during the time in question. Petitioner must demonstrate that his physical condition was such as to cause the payment of the maintenance fee to have been unavoidably delayed.

As Mr. Davis acknowledges that there was no docketing system in place to track the maintenance fee due date for the patent, unavoidable delay has not been shown. Mr. Davis' failure to maintain communication with his legal representation further cannot be found to have been unavoidable.

As the Office must look to the party responsible for paying the maintenance fee, the actions and inactions of both owners of record are material. Petitioner asserts that Mr. Davis is the sole owner of the patent by virtue of a verbal assignment between Mr. Davis and Mr. Klonne, details of which are set forth in a note written by Mr. Davis dated August 14, 2003.

"Assignment," in general, is the act of transferring to another the ownership of one's property, i.e., the interest and rights to the property. In 37 CFR 3.1, assignment of patent rights is defined as "a transfer by a party of all or part of its right, title and interest in a patent or patent application...." An assignment of a patent, or patent application, is the transfer to another of a party's entire ownership interest or a percentage of that party's ownership interest in the patent or application. In order for an assignment to take place, the transfer to another must include the entirety of the bundle of rights that is associated with the ownership interest, i.e., all of the bundle of rights that are inherent in the right, title and interest in the patent or patent application. See, MPEP 301. Furthermore, applications for patent, patents, or any interest therein, shall be assignable in law by an instrument **in writing**. (Emphasis added.) See, 35 USC 261.

Accordingly, it must be found that joint inventor Klonne remains an owner of the patent. Accordingly, Mr. Klonne's actions remain relevant to the failure to timely pay the maintenance fee. Petitioner asserts Mr. Klonne cannot be located. Nonetheless, absence a showing concerning the actions of Mr. Klonne to track, or engage someone to track the maintenance fee, Mr. Klonne's failure to timely remit the maintenance fee cannot be found to have been unavoidable.

Any renewed petition must establish that the entire period of delay from the time that the maintenance fee was due until the time of the filing of a grantable petition has been unavoidable. Petitioner is reminded that any renewed petition should entail an exhaustive effort to establish that the failure to timely pay the maintenance fee was unavoidable as after reconsideration pursuant to 37 CFR 1.378(e), no further reconsideration regarding unavoidable delay will be undertaken.

Further correspondence with respect to this matter should be addressed as follows:

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Any questions concerning this matter may be directed to the undersigned at (571) 272-3205.

/ALESIA M. BROWN/

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